

**REMARKS**

This application has been carefully reviewed in light of the Office Action mailed March 23, 2004. Claim 13 has been amended. Applicants respectfully request reconsideration and favorable action in this case.

**Drawings and Specification**

The Office Action objects to the drawings because FIGURE 4 does not show a reference number referring to "resistive section 35," as described on page 24, lines 13-29 of the present specification. Applicants correct FIGURE 4 to provide a reference number "35." In view of this correction, Applicants respectfully request the Examiner to withdraw the objection to the drawings.

The specification is objected to because page 25, line 2 of the present application refers to resistive section 35 as "resistive section 29." The specification is also objected to because page 26, lines 11-12 of the present specification does not indicate a unit for the resistive values. Applicants amend "resistive section 29" to read "resistive section 35." Further, Applicants amend the specification to provide "ohm" as the unit for the resistive values indicated on page 26, lines 11-12 of the specification. Favorable action is requested.

**Section 112 Rejections**

Claim 9 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states that the limitations of Claim 9 do not claim the same structure as the one described on page 20, lines 15-29 of the specification or shown in FIGURE 4, because, states the Office Action, "there are no sets of resistors in parallel with each other [in FIGURE 4]." Applicants respectfully disagree because the specification in fact does include an enabling description of the invention of Claim 9. For example, as shown in FIGURE 4, resistive element 30 is coupled in parallel to resistive element 32. Resistive element 34 is coupled in series to resistive element 30. Resistive element 36 is coupled in parallel to resistive element 34 and also coupled in series to resistive element 32. Resistive element 38 is coupled in series between the pair of resistive elements 30 and 34 and the pair of resistive elements 32 and 36. FIGURE 4 is also explicitly described on page 25, lines 19-29 of the Detailed Description section. Even if this were not the case, because Claim 9 is part of the original specification, it also provides enabling support. Thus, Claim 9 is fully enabled by the specification, and Applicants respectfully

submit that the rejection of Claim 9 under § 112 should be withdrawn. Favorable action is requested.

Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, because the claim does not provide a unit for the resistive value of 100. In response, Applicants amend Claim 13 to read “100 ohms.” In view of this amendment, rejection of Claim 13 under § 112, second paragraph, should be withdrawn. Favorable action is requested.

### Section 103 Rejections

The Office Action rejects Claims 1-8, 10, 11, 14, 15, 27-31, 33, 34, 35-37, and 39 under 35 U.S.C. § 103(a) as being unpatentable under U.S. Patent No. 4,246,582 issued to Kondo et al. (“*Kondo*”) and further in view of U.S. Patent No. 6,226,331 issued to Gambuzza (“*Gambuzza*”). The Office Action also rejects Claims 12, 13, 16, 17-26, and 38 under 35 U.S.C. § 103(a) as being unpatentable over *Kondo* in view of *Gambuzza*, and further in view of U.S. Patent No. 4,432,029 issued to Lundqvist (*Lundqvist*).<sup>1</sup> Applicants respectfully disagree for the reasons provided below.

Claim 1 is allowable over the proposed combination of *Kondo* and *Gambuzza* because the combination does not teach or suggest “a capacitive circuit coupled in series to the resistive circuit, the capacitive circuit operable to permit normal operation of telephone services at a subscriber premises,” as recited by Claim 1. The Examiner concedes that *Kondo* does not disclose “a capacitive circuit” recited by Claim 1, but argues that *Gambuzza* discloses such a capacitive circuit, and states that it would have been obvious for one of ordinary skill in the art to combine the capacitive circuit of *Gambuzza* with the device of *Kondo* “for the purpose of providing an isolation termination for the transceiver system disclosed by *Kondo*.”

The combination of *Kondo* and *Gambuzza* proposed by the Examiner is improper because such a combination would render the device of *Kondo* inoperable. Section 2143.01 of the M.P.E.P. states that “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” The proposed modification of *Kondo* using the capacitors of *Gambuzza* would render *Kondo* inoperable because such a capacitive

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<sup>1</sup> The Examiner never specifically addresses Claim 38, but instead addresses Claim 37 twice. In a good faith attempt to advance the prosecution of this case, Applicants read the rejection of Claim 37, which is based on *Kondo*, *Gambuzza*, and *Lundqvist*, as a rejection directed to Claim 38 because the substance of that rejection appears to apply to Claim 38 but not to Claim 37.

coupling would filter out low frequency signals - such as voice signals - that *Kondo* uses to perform its functions. The signals transmitted and received by the device of *Kondo* are low frequency signals, as shown by *Kondo*'s use of hybrid coil 16. As is well known in the art, a hybrid coil, such as hybrid coil 16 of *Kondo*, generally results in parasitic losses for high frequency signals. Because of the losses at high frequency signals, hybrid coil 16 is typically used in conjunction with devices that use low frequency signals for communication. Thus, the use of hybrid coil 16 in the device of *Kondo* indicates that the description of *Kondo* is directed to a low frequency device. However, the capacitors of *Gambuzza* are devices for **filtering out low frequency signals**. For example, *Gambuzza*, which is directed to an xDSL device (typically a high frequency device), states that "capacitors C1 and C2 provide DC voltage and **low frequency isolation** between line 312 and the local DTE because in typical applications, xDSL service is provided over ordinary telephone lines which are also used for voice services which are capable of generating DC and low frequency signals on the line." [emphasis added]. See column 5, lines 47-52 – *Gambuzza*. Given that the device of *Kondo* uses low frequency signals to communicate, modifying the device of *Kondo* using capacitors of *Gambuzza* - which are used to filter out low frequency signals - would prevent the device of *Kondo* from performing its communication functions because the capacitors would filter out the low frequency signals that *Kondo* needs to communicate. Thus, the proposed modification of *Kondo* using the capacitors of *Gambuzza* lacks the requisite motivation to make such a modification, and Claim 1 is allowable. Favorable action is requested.

For reasons analogous to those provided in conjunction with Claim 1, Claims 16, 27, and 35 are also allowable. Favorable action is requested.

As depending from their respective allowable independent claims, dependent Claims 2-15, 17-26, 28-34, and 36-39 are also allowable. Additionally, Claim 9 is allowable because Applicants overcame the §112 rejection of Claim 9 by showing that the present Application in fact does provide an enabling disclosure of the invention of Claim 9, and the Examiner provides no other basis for rejecting Claim 9. Thus, Claim 9 is allowable.<sup>2</sup> Favorable action is requested.

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<sup>2</sup> If the Examiner chooses to reject Claim 9 in the next Office Action based on a reason not asserted in the present Office Action, then the next Office Action making such a rejection of Claim 9 should be a non-final Office Action to allow Applicants at least one opportunity to amend Claim 9 based on the reasons for the rejection provided, for the first time, by the Examiner.

**Allowable Subject Matter**

Applicants appreciate the indication that Claims 8 and 32 are allowable if rewritten in independent form. In view of the reasons provided above in support of allowing other pending claims, Applicants elect to defer the amendment of Claims 8 and 32.

CONCLUSION

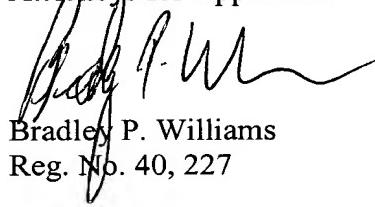
Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6447.

Applicants do not believe that any fees are due. However, the Commissioner is hereby authorized to charge these fees and any extra fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
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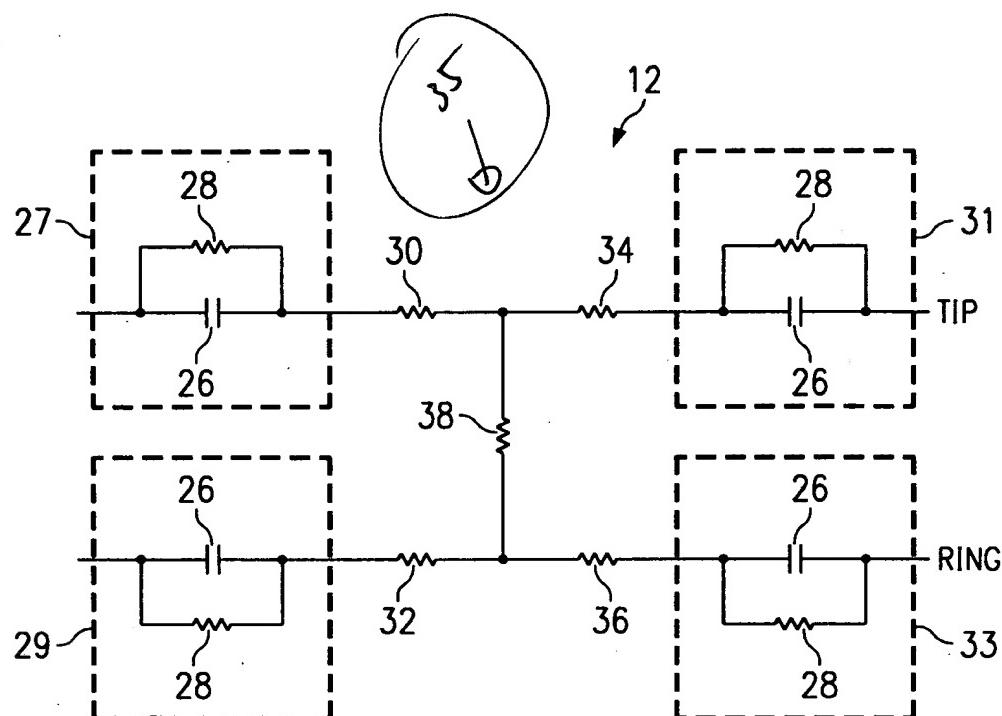
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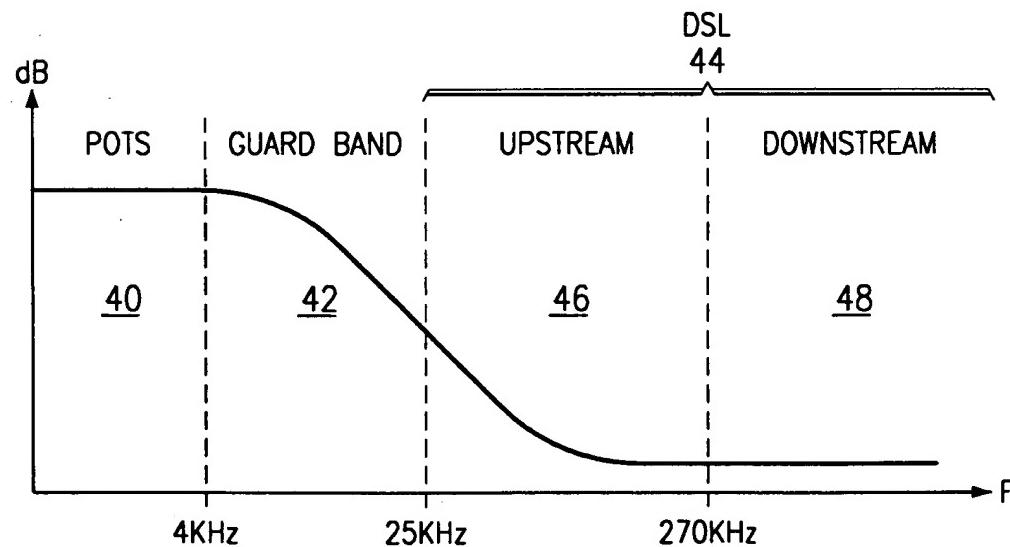
Attenuation to Data Signals in an XDSL Frequency Range

Inventors: Capon, et al.  
 Attorney Docket No. 062891.0439  
 Sheet 2 of 2  
 Filed: December 19, 2000

ANNOTATED MARKED UP DRAWING



*FIG. 4*



*FIG. 5*